

24 are objected to. Claims 1, 25-33, 46, 66, 86-89, 92, 93, and 96 have been amended to correct typographical errors noted by the Examiner on pages 3-8 of the Office Action. No new matter has been added and Patent Owner respectfully requests entry of the amendments. Claims 25-29 have been amended to remove the acyl and (C<sub>2</sub>-C<sub>11</sub>) alkanoyl moieties from the definition of R since those groups are covered by the recitation of R being C(=O)alkyl. No new matter has been introduced and Patent Owner respectfully requests entry of the amendments. Claims 9, 25-27, 54, 74, and 104 have been amended and claims 49 and 57 have been cancelled to remove the rejections for lack of antecedent basis (items (k), (l), (ee), (ff), (gg), (hh), (ii), and (ll)). No new matter has been added and Patent Owner respectfully requests entry of the amendments. Finally, claims 46, 66, 86-89, 92, and 93 have been amended to add the term “as” in the definition of “aryl” as invited by the Examiner in item (dd). No new matter has been added and Patent Owner respectfully requests entry of the amendments.

#### **Amendment to Title**

On page 2 of the Office Action, the Examiner notes that the preliminary amendment requesting the title change has not been entered since the term “Piperidines” does not appear in the title. In this amendment, Patent Owner has requested amendment of the title to change the term “Heteroaryl piperidines” to --Heteroaryl piperazines--.

#### **Reissue Declaration**

The Examiner has found the reissue declaration filed with the instant reissue application to be defective because it fails to state that the applicants are the original **and first** inventors. Patent Owner herein provides a replacement reissue declaration that includes the “original and

first joint inventors" language. Patent Owner respectfully requests that the rejection be withdrawn.

### **Specification**

The Examiner has requested that the specification be amended to cross-reference related co-pending divisional or continuation reissue applications. Patent Owner notes that the instant reissue application is not a division or continuation of another co-pending reissue application pursuant to 37 C.F.R. § 1.177(a). However, Patent Owner has herein requested amendment of the first paragraph of the specification to cross-reference Reissue Application No. 09/712,129, based on U.S. Pat. No. 5,364,866.

### **Rejections under 35 U.S.C. § 112**

#### **A. Rejections under 1<sup>st</sup> Paragraph of § 112**

Claims 25-29, 35-39, 44, and 45 have been rejected for allegedly lacking written description of the claimed subject matter where R is acyl or (C<sub>2</sub>-C<sub>11</sub>) alkanoyl. In the foregoing amendment Patent Owner has deleted these moieties from the definition of R since the group C(=O)alkyl covers the subject matter where R is acyl or (C<sub>2</sub>-C<sub>11</sub>) alkanoyl. Accordingly, Patent Owner respectfully requests that the rejection be withdrawn.

#### **B. Rejections under 2<sup>nd</sup> Paragraph of § 112**

Patent Owner thanks the Examiner for her attention to the details of the complicated claim language in the instant reissue application. In the foregoing amendment, Patent Owner has addressed the various typographical errors noted by the Examiner in claims 1, 25-33, 46, 66, 86-

89, 92, 93, and 96. Patent Owner has not corrected the typographical error in claim 31 noted by the Examiner in item (cc) since, although the Patent Owner notes that the word "a" should be --and--, the phrase "a p" appears in a portion of the claim that is being deleted from issued claim 31. With respect to claims 9, 25-27, 49, 54, 57, 74, and 104 (items (k), (l), (ee), (ff), (gg), (hh), (ii), and (ll)), Patent Owner has amended claims 9, 25-27, 54, 74, and 104 to remove the moieties recited by the Examiner as lacking antecedent basis. Similarly, Patent Owner has cancelled claims 49 and 57 since these claims are directed to subject matter that is not recited in the independent claims.

#### **Rejection under 35 U.S.C. § 102**

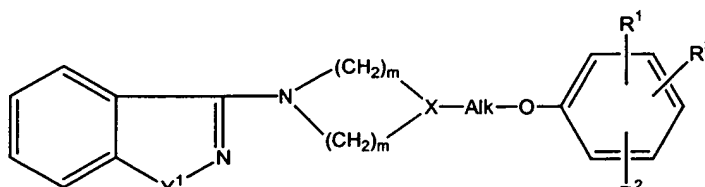
The Examiner has rejected claims 25-29, 35-39, 44, and 45 under 35 U.S.C. § 102(b) as allegedly anticipated by Strupczewski et al. (EP 402,644). The Examiner states that these claims have not been accorded benefit of applications filed prior to the November 9, 2000, filing date of the reissue application. As stated above, Patent Owner has deleted the moieties "acyl" and "(C<sub>2</sub>-C<sub>11</sub>) alkanoyl" from the definition of R in claims 25-29. Patent Owner respectfully submits that the amended definition for R as recited in these claims may be found in the '911 patent in columns 24-25 and in great, great, great grandparent Application No. 06/456,790, filed December 29, 1989, on page 7, line 9-page 8, line 5. Thus, since claims 25-29, 35-39, 44, and 45 are entitled to a priority date of December 29, 1989, they cannot be anticipated by Strupczewski, which was published on December 19, 1990. Accordingly, Patent Owner respectfully requests that the rejection be withdrawn.

#### **Rejections under 35 U.S.C. § 103**

A. Rejection over Stokbroekx et al.

The Examiner has rejected claims 1-6, 10-13, 30, 35, 44, and 45 under 35 U.S.C. § 103(a) as allegedly obvious over Stokbroekx et al. (EP 0 398 425) ("Stokbroekx").

Stokbroekx is directed to piperidinyl, pyrrolidinyl, and piperazinyl alkylphenol ethers of the formula



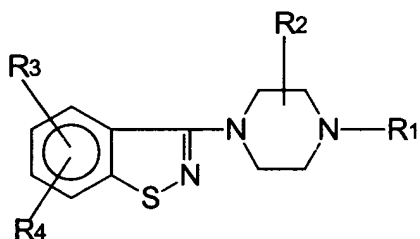
where Y<sup>1</sup> is O, S or SO<sub>2</sub>, X is N or CH and Alk is a C<sub>1-4</sub> alkanediyl, which is defined as a bivalent straight or branched chained hydrocarbon radical having 1-4 carbons. See page 3, line 10 to page 4, line 28 of Stokbroekx. These compounds bear a relation to the claimed piperazinyl derivatives where X is -O- or -S-. The Alk group of the Stokbroekx compounds bears a relation to the R<sub>1</sub> group of the claimed invention.

The claimed invention, however, specifically excludes the compounds of Stokbroekx by reciting the following proviso in independent claims 1 and 30: "with the exclusion of compounds wherein X is O or S, Y is hydrogen, and R is hydrogen, C<sub>1-4</sub> alkyl, chlorine, fluorine, bromine, iodine, cyano, C<sub>1-4</sub> alkoxy, aryl, or -COOR<sub>23</sub> where R<sub>23</sub> is C<sub>1</sub>-C<sub>4</sub> alkyl." Thus, the claims embrace subject matter neither taught nor even suggested by Stokbroekx and the rejection should be withdrawn.

*B. Rejection over Smith et al.*

The Examiner has rejected claims 1-4, 6, 9-13, 25, 27, 30, 33-35, 38-39, and 42-45 under 35 U.S.C. § 103(a) as allegedly obvious over Smith et al. (U.S. Pat. No. 4,590,196) ("Smith").

Smith discloses 1,2-benzisothiazol-3-yl piperazine compounds of the formula



where  $R^1$  may be aralkyl, aryloxyalkyl or benzodioxan-2-yl-alkyl;  $R^2$  is alkyl or hydrogen; and  $R^3$  and  $R^4$  are hydrogen, alkyl, acyloxy, alkoxy, alkylthio, halogen, hydroxyl, or trifluoromethyl. These compounds bear a relation to the claimed compounds where X is -S-. When  $R^1$  of Smith is aryloxyalkyl, these compounds bear a relation to the claimed compounds where R is H.


The claims, however, specifically exclude the compounds of Smith in the proviso reciting: "with the exclusion of compounds wherein X is -S-, R is H, and  $m=1$ ." Thus, the amended claims embrace subject matter neither taught nor even suggested by Smith, and the rejection should be withdrawn.

As noted in the Consent of Assignee, Offer to Surrender Original Patent, and Statement under 37 C.F.R. § 3.73(b) filed November 9, 2000, Patent Owner intends to surrender the original Letters Patent when the reissue application is in condition for allowance.

For the foregoing reasons, Patent Owner respectfully submits that claims 1-48, 50-56, and 58-115 are in condition for allowance, and early notification to this effect is courteously requested.

If there are any fees due in connection with the filing of this response not already accounted for, please charge the fees to our Deposit Account No. 18.1982.

Respectfully submitted,

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